

REMARKS/ARGUMENTS

Favorable reconsideration of this application, as presently amended and in light of the following discussion, is respectfully requested.

Claims 50-65 are pending in the present application, Claims 50-65 having been added, and Claims 24, 26-34, 36-42, and 44-49 having been canceled without prejudice or disclaimer. Support for the present amendment is believed to be self-evident from the originally filed specification.¹ Applicants respectfully submit that no new matter is added.

In the outstanding Office Action, Claims 24, 31, 34, and 42 were rejected under 35 U.S.C. §103(a) as unpatentable over Takeda et al. (U.S. Patent No. 5,845,057, hereinafter Takeda) in view of Kakutani (U.S. Patent No. 6,817,794); Claims 27, 29, 37, 39, 45, and 47 were rejected under 35 U.S.C. §103(a) as unpatentable over Takeda in view of Kakutani, and further in view of de Koning et al. (U.S. Patent No. 6,266,512, hereinafter de Koning); Claims 28, 32, 38, and 46 were rejected under 35 U.S.C. §103(a) as unpatentable over Takeda in view of Kakutani, and further in view of Shukunami et al. (U.S. Patent No. 5,031,116, hereinafter Shukunami); Claims 30, 40, and 48 were rejected under 35 U.S.C. §103(a) as unpatentable over Takeda in view of Kakutani, and further in view of Yoshida (U.S. Patent No. 5,917,612); Claims 33, 41, and 49 were rejected under 35 U.S.C. §103(a) as unpatentable over Takeda in view of Kakutani, and further in view of Hattori (U.S. Patent No. 6,512,599); and Claims 26, 36, and 44 were rejected under 35 U.S.C. §102(b) as anticipated by Takeda.

The outstanding grounds of rejection are moot in view of the cancelation of Claims 4, 26-34, 36-42, and 44-49. Applicants respectfully submit that new Claim 50 patentably distinguishes over Takeda, Kakutani, de Koning, Shukunami, Yoshida, and Hattori, alone or when taken in proper combination. New Claim 50 recites, *inter alia*,

¹ See, for example, page 21, lines 10-21, page 24, line 24 to page 27, line 6 of the specification and Applicants' Fig. 2.

a reducing unit configured to reduce the image data based on a size of a substitute recording medium, when a recording medium having the recording medium size is unavailable and the image data is to be formed on the substitute recording medium that is smaller than the recording medium size received by the receiving unit; and

a forming unit configured to form on the substitute recording medium the image data that is reduced by the reducing unit.

Takeda, Kakutani, de Koning, Shukunami, Yoshida, and Hattori do not disclose or suggest at least this feature of Claim 50.

Takeda describes a system and method that determines another printing apparatus for a substitutive printing.² If a depletion of paper having the size designated by the user is detected, then the paper may be changed to substitutive paper size designated with reference to the document management table 420.³ Fig. 12 shows an example of the document management table 420. This table does not include information regarding the reduction of the image data. Thus, Takeda does not disclose or suggest the above-noted features of Claim 50.

Kakutani describes a “printer which selects one of a plurality of trays, and prints on paper stored in the selected tray based on printing job data specifying a paper size, a paper type, and a tray from a host device.”⁴ For one embodiment, Kakutani states:

For example, as shown in FIG. 1, in the tray set table 10, a size A' and a type X' are set in a tray 1, and a size A" and a type X" are set in a tray 2. Accordingly, in the case where the paper size and paper type of specifying information included in the printing job data from the host device are A, X, respectively, the size and type of the papers stored in the trays 1, 2 do not agree with those of the specifying information. However, in the alternative table 20 of the printer, for example, if the paper size A and the paper type X are registered corresponding to the tray 1, the printer

² Takeda, abstract.

³ Takeda, col. 15, lines 35-50.

⁴ Kakutani, col. 1, lines 6-10.

does not become in the disagreement error condition, and prints by use of the papers stored in the tray 1 in accordance with the alternative table 20.⁵

Alternative table 20 does not include information regarding the reduction of the image data. Thus, Kakutani does not disclose or suggest the above-noted features of Claim 50.

de Koning describes a system that automatically selects a copy substrate from multiple substrate trays.⁶ When no copy sizes match the input document size, the controller selects a copy substrate that most corresponds to the size of the input documents.⁷ de Koning describes that the controller determines whether the image file can fit onto the substrate size selected by “shrinking or expanding the margins of the document.”⁸ Col. 10, lines 51-57 of de Koning describes magnifying or shrinking the image area, which refers to the area on the recording medium defined by the margins. A controller that shrinks the margins or shrinks the image area on the recording medium is not the same as the “reducing unit configured to *reduce the image data*” of Claim 50. Thus, de Koning does not disclose or suggest the above-noted features of Claim 50.

Shukunami describes an image forming system. If a desired image forming medium is not available, the image data is edited to allow a desired image to be formed on an arbitrary image forming medium as a substitute for a desired image forming medium.⁹ What this means, in the context of Shukunami, is that the image data is changed between landscape and portrait orientations in order to fit the available recording medium.¹⁰ The embodiments illustrated by Shukunami’s Figs. 11 and 12 show that different paper sizes may be used, but that there is no reduction in the image data (i.e., the image data remains the same size). Thus, Shukunami does not disclose or suggest the above-noted features of Claim 50.

⁵ Kakutani, col. 5, lines 16-27.

⁶ de Koning, abstract.

⁷ de Koning, col. 9, lines 18-26.

⁸ de Koning, col. 9, lines 26-30.

⁹ Shukunami, abstract.

¹⁰ Shukunami, col. 7, line 60 to col. 8, line 59.

Yoshida describes a facsimile machine that records a plurality of pages on one page.¹¹

Yoshida states:

If a discrimination has been made in accordance with the recognized number of lines that received information exceeds the A4 size by 1 cm or less, rear end information is omitted and data is recorded on the recording 40 paper at the same magnification. If received information exceeds the A4 size by a degree ranging from 1 cm to 2.97 cm, data is recorded by reducing the original at a reduction ratio of 90%. If received information exceeds the A4 size by a degree larger than 2.97 cm, original data is divided into 45 two or more pages.¹²

However, Yoshida does not describe that image data is reduced “when a recording medium having the recording medium size is unavailable and the image data is to be formed on the substitute recording medium that is smaller than the recording medium size.” Furthermore, Yoshida does not describe switching between a designated recording medium size and a substitute recording medium size. Rather, Yoshida describes a facsimile machine that user one type of paper at a “regular size.” Thus, Yoshida does not disclose or suggest the above-noted features of Claim 50.

Figs. 11 and 12 of Hattori describe a print tray selection process.¹³ Cols. 22-24 of Hattori describe switching between tray 1 and tray 2, and having the user perform an operation on operation panel 83 to command printing on a mismatched paper size.

Col. 10, line 64 to col. 11, line 14 of Hattori describes reduction recording, wherein images printed by a facsimile machine are reduced in the lengthwise direction. Hattori either reduces the image data (i.e., with automatic mode where the % reduction varies or with a fixed 90%) or does not reduce the image (reduction recording OFF). Hattori does not describe that that reduction recording is performed “when a recording medium having the

¹¹ Yoshida, col. 1, lines 10-12 and col. 6, lines 23-25.

¹² Yoshida, col. 8, lines 38-45.

¹³ Hattori, col. 22, lines 23-25.

recording medium size is unavailable and the image data is to be formed on the substitute recording medium that is smaller than the recording medium size.”

In view of the above-noted distinctions, Applicants respectfully submit that a person of ordinary skill in the art could not properly combine Takeda, Kakutani, de Koning, Shukunami, Yoshida, and Hattori to arrive at the invention defined by Claim 50 because none of these references describes the claimed:

a reducing unit configured to reduce the image data based on a size of a substitute recording medium, when a recording medium having the recording medium size is unavailable and the image data is to be formed on the substitute recording medium that is smaller than the recording medium size received by the receiving unit; and

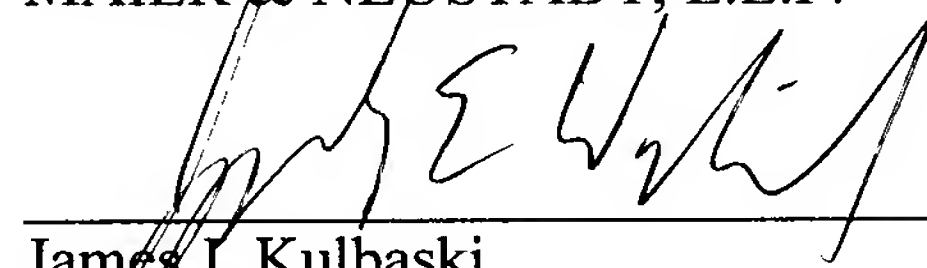
a forming unit configured to form on the substitute recording medium the image data that is reduced by the reducing unit.

Accordingly, Applicants respectfully submit that Claim 50 (and any claims dependent thereon) patentably distinguish over Takeda, Kakutani, de Koning, Shukunami, Yoshida, and Hattori, when taken in proper combination. Claim 58 recites features analogous to those of Claim 50. Thus, Applicants respectfully submit that Claim 58 (and any claims dependent thereon) patentably distinguish over Takeda, Kakutani, de Koning, Shukunami, Yoshida, and Hattori, when taken in proper combination, for at least the reasons stated for Claim 50.

Consequently, in light of the above discussion and in view of the present amendment, the present application is believed to be in condition for allowance and an early and favorable action to that effect is respectfully requested.

Respectfully submitted,

OBLON, SPIVAK, McCLELLAND,
MAIER & NEUSTADT, L.L.P.



James J. Kulbaski
Attorney of Record
Registration No. 34,648

Customer Number
22850

Tel: (703) 413-3000
Fax: (703) 413 -2220
(OSMMN 07/09)

Joseph E. Wrkich
Registration No. 53,796